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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,340	04/21/2005	Terry Beaumont	9052-205	8759
20792	7590	08/14/2006	EXAMINER	
MYERS BIGEL SIBLEY & SAJOVEC PO BOX 37428 RALEIGH, NC 27627			BERHANU, ETSUB D	
			ART UNIT	PAPER NUMBER
			3768	

DATE MAILED: 08/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/506,340	BEAUMONT, TERRY	
	Examiner	Art Unit	
	Etsub D. Berhanu	3768	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/1/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/1/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Sarnoff'094 (cited by applicant).

Sarnoff'094 discloses a sensing device comprising: physiological sensing means comprising pulse oximetry optical transmitters and a receiver, and a temperature sensor in contact with a heat transfer tip (page 7, lines 1-14); locating means to locate the sensing means inside an ear canal, wherein the locating means is provided with an aperture which, when the sensing device is fitted in the ear canal, allows motion of the air in and out of the ear canal (see Figure 3 and page 10, lines 6-22); a generally U-shaped locating means (see Figures 2 and 3); locating means made of pliable material which is adapted to fit comfortably within the ear canal, and wherein the locating means comprises adjusting means such that the device can be comfortably accommodated by a multiplicity of different users (page 9, line 27 – page 10, line 2); locating means made of silicone (page 4, lines 23-26); and an audio communication means wherein the audio communication means comprises a microphone located within a vibration absorbent material, wherein the absorbent material is a thermoplastic elastomer (page 4, line 23 – page 5, line 7).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarnoff'094, as applied to claim 1, and further in view of Schulze et al.'692 (cited by applicant).

Sarnoff'094 discloses all of the elements of the current invention, as discussed in paragraph 2, except for the locating means comprising securing means, wherein the securing means comprises an ear clip which partially or completely surrounds the top or bottom of the ear.

Schulze et al.'692 teaches the use of an adjusting and securing means comprising an ear clip which partially or completely surrounds the ear around the top or bottom of the ear in order to secure an optical sensor to an ear (col. 5, lines 49-56).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the locating means of Sarnoff'094 to include the securing means of Schulze et al.'692, since it would allow the optical sensors of Sarnoff'094 to be secured to the ear.

5. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarnoff'094, as applied to claim 1 above, and further in view of Raff'931 (cited by applicant).

Sarnoff'094 discloses all of the elements of the current invention, as discussed in paragraph 2, except for the audio communication means comprising a speaker.

Raff'931 teaches the use of a speaker in an audio communication means in a monitoring ear piece system to orally communicate between a patient and a nursing station (col. 2, lines 33-36).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the audio communication means of Sarnoff'094 to include a speaker, as taught by Raff'931, since it would allow audible communication between a patient and nursing station.

Regarding claim 15, it is noted that while Sarnoff'094 discloses the use of a thermoplastic elastomer or thermoset silicone as material for the earmold locating means, Sarnoff'094 fails to disclose a specific thermoplastic elastomer or thermoset silicone. It would have been within the skill of the art to determine an appropriate thermoplastic elastomer or thermoset silicone including one with a shore hardness between 30 and 60 % in order to assure that the locating means is pliable so as to be adjusted for the use by multiple users, and also comfortable when inserted in a patient's ear canal.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shulze et al.'852 (US Patent No. 6,556,852) discloses a U-shaped ear piece with pulse oximetry transmitters and receivers and a temperature sensor, with locating means made of a pliable material.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etsub D. Berhanu whose telephone number is 571.272.6563. The examiner can normally be reached on Monday - Friday (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (571)272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EDB

ERIC F. WINAKUR
PRIMARY EXAMINER